

PATENT

Application Serial No. 09/535,790  
Attorney Docket No. 99-032R E M A R K S

- Claims 1-167 were pending in the present application
- Claims 1-167 stand rejected

Upon entry of this amendment, which is respectfully requested for the reasons set forth below:

- Claims 1-167 will be pending
- Claims 67, 75, 76, 92, 111, and 154-157 will be amended
- Claims 1, 48, 58, 75-79, 81-88, 90-96, 107-112, 125, 129-131, 136-138, and 144-167 will be the only independent claims

Telephone Interview

Applicants would like to thank the Examiner for the telephone conversation held on December 3, 2002 with Applicants' representative. The Examiner and Applicants' representative discussed independent Claim 1 in light of the Christensen and Kanter references. Applicants' representative suggested that neither Christensen nor Kanter, alone or in combination, teaches or suggests a feature generally directed to *updating said coupon's benefit in accordance with said benefit variation condition*, as recited in independent Claim 1.

While no formal agreement with respect to the patentability of Claim 1 was reached, Applicants are grateful for the opportunity to discuss the present application with the Examiner.

Claim Amendments

Claims 67, 75, 76, 92, 111, and 154-157 have been amended to correct minor typographical errors

Claims 67, 75, 76, 92, 111, and 154-157 have been amended to correct minor and obvious typographical errors. No new matter has been added, and no amendment was made for reasons relating to patentability.

Applicants Request Further Clarification to Aid in Examination

Applicants respectfully submit that the terse and summary nature of the Office Action has made it difficult to discern either (i) what portion of a reference the Examiner believes suggests a particular feature or (ii) how the Examiner is interpreting a particular claim feature. For example, the Examiner does not indicate, with respect to any reference, a particular relevant disclosure in any reference that teaches or suggests a feature of any claim. Particularly, with respect to all of the pending claims (Claims 1-167) and without reference to any particular feature, the Examiner merely asserts:

Christensen (the ABSTRACT; FIG. 1 through FIG. 14; col. 1, ll. 13-65; col. 2, ll. 3-67; col. 3, ll. 4-57; col. 4, ll. 15-63; col. 5, ll. 29-67; col. 6, ll. 1-65; col. 7, ll. 67; col. 8, ll. 1-67; col. 9, ll. 1-65; col. 10, ll. 1-67; col. 11, ll. 4-65; col. 12, ll. 4-65; col. 13, ll. 18-67; col. 14, ll. 1-67; col. 15, ll. 1-67; col. 16, ll. 1-60; and col. 17, ll. 1-44) shows elements that suggest the elements and limitations

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of all of Claims 1-167. [Office Action, pages 3, 5, 6, 7, 8, 10, 12, 14, 16, 18, 19, 21, 22.]  
Further, Applicants note that the Examiner asserts:

Kanter (the ABSTRACT; FIG. 1; col. 1, ll. 13-65; col. 2, ll. 3-67; col. 3, ll. 4-57; col. 4, ll. 15-63; col. 5, ll. 29-67; col. 6, ll. 1-65; col. 7, ll. 67; col. 8, ll. 1-67; col. 9, ll. 1-65; col. 10, ll. 1-67; col. 11, ll. 4-65; col. 12, ll. 4-65; col. 13, ll. 18-67; col. 14, ll. 1-67; col. 15, ll. 1-67; col. 16, ll. 1-60; col. 17, ll. 1-44; col. 18, ll. 7-67; col. 19, ll. 1-67; col. 20, ll. 1-67; col. 21, ll. 1-67; col. 22, ll. 1-67; col. 23, ll. 2-67; col. 24, ll. 1-67; col. 25, ll. 1-67; col. 26, ll. 1-67; col. 27, ll. 1-67; and col. 28, ll. 1-67) shows elements that suggest

various elements of all of independent Claims 1, 48, 58, 75-79, 81-88, 90-96, 107-112, 125, 129-131, 136-138, and 144-167.

Applicants respectfully submit that the asserted citations as to where relevant disclosure may supposedly be found in the Kanter reference are identical to the citations provided for the Christensen reference for the first seventeen columns. Applicants respectfully submit that the Examiner has inadvertently copied most of the asserted citations for the Kanter reference from those provided for the Christensen reference.

In any subsequent Office Action, Applicants respectfully request that the Examiner clarify the factual assertions as to which references teach or suggest which particular features of specific claims, and provide the most relevant citations in the references.

### Section 103(a) Rejection

Claims 1, 48, 58, 75-79, 81-88, 90-96, 107-112, 125, 129-131, 136-138, and 144-167 stand rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,710,886 issued to Christensen et al. (hereinafter "Christensen") in view of U.S. Patent No. 5,357,314 issued to Kanter, et al. (hereinafter "Kanter").

Claims 2-47, 49-57, 59-74, 80, 89, 97-106, 113-124, 126-128, 132-135, and 139-143 stand rejected under 35 U.S.C. 103(a) as being obvious over Christensen in light of Kanter and in light of the Examiner's Official Notice of various asserted subject matter.

Applicants respectfully traverse the Examiner's Section 103(a) rejections.

#### 1. Christensen Does Not Suggest All of the Features of All of Claims 1-167

The Examiner asserts that even where Christensen "lacks explicit recitation" of a feature of a claim, it nonetheless suggests all of the "elements and limitations" of each of the pending Claims 1-167. [Office Action, pages 3, 5, 6, 7, 8, 10, 12, 14, 16, 18, 19, 21, 22.] Applicants respectfully traverse this omnibus assertion as to what Christensen "suggests." So that Applicants may best assist the Examiner with the examination of the present application, Applicants respectfully request that the Examiner clarify what features of pending Claims 1-167 Christensen teaches or suggests, by providing the most relevant citations for the subject matter that the Examiner believes suggests each particular feature of all of Claims 1-167.

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Application Serial No. 09/535,790  
Attorney Docket No. 99-0322. Independent Claim 12.1. The References Do Not Disclose All the Limitations of Independent Claim 1

As best understood by Applicants, the Examiner asserts the following to be true with respect to independent Claim 1:

(a) Christensen teaches all of the features of Claim 1 except  
• *establishing a benefit variation condition for said coupon, said benefit variation condition having at least one associated qualifying action*

(b) Kanter suggests the above feature

Applicants respectfully traverse these assertions. Applicants have carefully reviewed the Christensen and Kanter references cited by the Examiner, without finding a teaching or suggestion of *a benefit variation condition for a coupon*, much less *a benefit variation condition having at least one associated qualifying action*, much less *establishing such a benefit variation condition for a coupon*.

Independent Claim 1 recites *establishing an initial benefit of a coupon*, and *establishing a benefit variation condition for said coupon*. Various embodiments of the present invention are directed to providing a coupon having a benefit that is variable or alterable according to established benefit variation condition(s). Thus, the benefit of the coupon may vary, before and/or after the coupon is redeemed by an initial recipient, depending on the established benefit variation condition(s) and the actions of the initial recipient of the coupon, other recipients of the coupon, other parties, external events, etc. [Specification, page 7, lines 27 – 32.]

In contrast, and contrary to the Examiner's assertion, Kanter is devoid of any hint or suggestion of *a benefit variation condition for said coupon*, as recited in independent Claim 1. Kanter describes:

an incentive program which also allows a sponsoring financial institution to issue to participants, rebates...which can be redeemed in cash, coupons, checks, catalog products, trips, goods or service from designated merchants, or any combination thereof

[Column 15, lines 19-25.] Kanter thus describes a system in which a rebate may be redeemed in the form of a coupon. There is nothing in Kanter, however, that would suggest that a coupon in the Kanter system, once issued, has a variable benefit; the coupon, like the alternatives of cash or catalog products, is merely a fixed form of the issued rebate. Accordingly, there is nothing in Kanter that would suggest *a benefit variation condition of a coupon*, much less that *the benefit variation condition has at least one associated qualifying action*.

In addition, Applicants respectfully traverse the Examiner's assertion that Christensen discloses the following features:

- *receiving notice of a completion of said at least one qualifying action*
- *updating said coupon's benefit in accordance with said benefit variation condition*

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The Examiner does not assert that Kanter discloses either of the above features.

Applicants have carefully reviewed both the Christensen and Kanter references cited by the Examiner, without finding a teaching or suggestion of either of the above features. Specifically, as neither Christensen nor Kanter teaches or suggests a *benefit variation condition of a coupon*, Christensen and Kanter cannot disclose features directed to either (i) *receiving notice of a completion of said least one qualifying action* that is associated with a *benefit variation condition of said coupon* or (ii) *updating said coupon's benefit in accordance with said benefit variation condition*, as recited in independent Claim 1.

Applicants respectfully submit that the references do not disclose all of the limitations of independent Claim 1. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim 1.

If, on the other hand, Applicants' understanding as to what the Examiner is asserting with respect to independent Claim 1 is incorrect, Applicants request clarification of the list of items (a) - (b) above so that the present application may proceed to allowance or appeal.

## 2.2. No Motivation to Combine the Cited References

As best understood by Applicants, the Examiner also asserts the following to be true with respect to independent Claim 1:

- (c) It would have been obvious to one of ordinary skill in the art to modify Christensen in light of Kanter to provide for a feature of *establishing a benefit variation condition for said coupon, said benefit variation condition having at least one associated qualifying action*
- (d) The motivations for this modification in (c) above would be
  - (i) to provide means by which "a participant can join in a merchant's multilevel selling campaign and/or incentive award program and redeem their earnings.... wherein discounts apply on calls placed to certain individuals by those that recruited the individuals.... To provide an incentive award program which can motivate participants to make referrals on behalf of the program..." (citing Kanter); and
  - (ii) to provide means "to improve consumer response to coupon distribution campaigns...[and] to provide more accurate data of which consumers redeem particular coupons in a coupon distribution campaign." (citing Christensen)

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 706.02(j). In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 21 USPQ2d 1941 (Fed. Cir. 1992).

In view of the above, the Examiner must show that the prior art of record provides the motivations of (d) above. MPEP 2143. Further, the Examiner must show that the asserted motivations of (d) above include a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art to produce the specific features of the claimed invention. Applicants have carefully reviewed the Office Action issued in the present application, as well as the references cited by the Examiner, without finding a

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motivation anywhere in the record that suggests the desirability of combining or modifying the cited references in the manner proposed by the Examiner.

Applicants respectfully submit that the Christensen and Kanter references are not analogous art. It is a described object of the Christensen system to improve consumer response to coupon distribution campaigns, to provide more accurate data of which consumers redeem particular coupons in a coupon distribution campaign, and to reduce the incidence of fraud in the redemption of coupons or copying of coupons. [Column 4, lines 43 - 54.] Christensen is accordingly directed to an apparatus and method for distributing, generating, authenticating, and redeeming discount coupons and the like electronically. [Column 1, lines 5 - 7.]

In contrast, Kanter teaches away from these objects of Christensen. As described in Kanter, coupon distribution campaigns involve a promotional technique that is "an administrative nightmare," is "very time consuming," "can have a detrimental effect on a merchant's cash flow," is confusing to consumers, and "creates massive paper waste." [See, Column 1, line 32 to Column 2, line 7.] As an explicit alternative to coupon distribution campaigns, Kanter thus is directed to an incentive award program to provide "an advertising campaign and which is a convenient and an economical alternative to traditional advertising as...the burdens associated with coupon and ad designing, ad printing, target marketing and related aspects are eliminated...." [Column 12, lines 50-55.] Thus, as described above with respect to independent Claim 1, "coupons" are described in Kanter solely as a form of redeemed earnings awarded in an incentive program, and not as part of an advertising or promotional campaign, as described in Christensen.

Further, the motivations of (d), as asserted by the Examiner, would not suggest the desirability of modifying the coupon distribution system of Christensen to provide specifically for the feature of *establishing a benefit variation condition of said coupon, said benefit variation condition having at least one associated qualifying action*, as recited in independent Claim 1. The Examiner does not provide any reasoning or support in the evidence of record as to why the asserted desirability of "a merchant's multilevel selling campaign and/or incentive award program and redeem their earnings", "an incentive award program which can motivate participants to make referrals on behalf of the program", "to improve consumer response to coupon distribution campaigns", or "to provide more accurate data of which consumers redeem particular coupons in a coupon distribution campaign", would specifically suggest to one of ordinary skill in the art the desirability of *establishing a condition for varying the benefit of a coupon* in the Christensen system to meet any of the asserted desirable objectives.

Accordingly, the asserted motivations in the Kanter and Christensen references amount to a mere statement by the Examiner that the proposed combination or modification would be advantageous. This statement does not meet the requirement of evidence of a motivation in the prior art to combine the particular asserted teachings in the manner proposed by the Examiner. Applicants respectfully submit that the purported motivations do not suggest any such modification of the Christensen system.

Also, the asserted motivation "wherein discounts apply on calls placed to certain individuals by those that recruited the individuals" suggests neither that a benefit of a coupon may vary, nor a *condition for varying the benefit of a coupon*, much less a motivation for modifying the coupon distribution campaign system of Christensen. In fact, Kanter describes such "discounts on calls" as an incentive that was not available in the prior art to be offered by "any company that is not a telecommunication service distributor, as obviously, such companies do not sell telecommunication services." [Column 14, lines 16-26.] It is not clear to Applicants

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how Kanter's description of how discounts on calls were previously unavailable as incentives for non-telecommunication companies suggests either a motivation to *establish a benefit variation condition of a coupon* or a motivation to modify the coupon distribution campaign system of Christensen; Applicants respectfully request clarification of the Examiner's reasoning.

Applicants respectfully submit that the there is no suggestion in the prior art of record to combine the particular asserted teachings of the prior art to provide for all of the features of independent Claim 1. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim 1.

If, on the other hand, Applicants' understanding of what the Examiner is asserting to be true is incorrect, Applicants request clarification of the list of items (a) - (d) above so that the present application may proceed to allowance or appeal.

3. Independent Claims 48, 58, 77-79, 81-88, 90-96, 107-108, 112, 125, 129-131, 144-153, and 158-167

The Examiner rejects all of independent Claims 48, 58, 77-79, 81-88, 90-96, 107-108, 112, 125, 129-131, 144-153, and 158-167 "for substantially the same reasons" as independent Claim 1. Accordingly, for at least the reasons stated herein with respect to independent Claim 1, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to any of independent Claims 48, 58, 77-79, 81-88, 90-96, 107-108, 112, 125, 129-131, 144-153, and 158-167.

Further, Applicants respectfully submit that none of the references, alone or in combination, teaches or suggests *changing a benefit associated with a coupon upon receiving notice of a completion of a qualifying action associated with the coupon*. The Examiner does not explicitly assert otherwise. Accordingly, Applicants respectfully submit that the cited references do not suggest any of the following features:

- *establishing a first qualifying action associated with said coupon*
- *changing said coupon's associated benefit a first amount upon receiving notice of a completion of said first qualifying action*

as recited in independent Claim 48; or

- *associating a first qualifying action with a coupon, whereby a benefit for said coupon changes upon completion of said first qualifying action by a first recipient of said coupon*
- *changing said benefit of said coupon upon receipt of an indication of completion of said first qualifying action by said first recipient*

as recited in independent Claim 58.

Applicants also respectfully submit that none of the references, alone or in combination, teaches or suggests *increasing a benefit of a coupon having a variable benefit after receiving an indication after a second recipient (i) registers a duplicate of the coupon, (ii) registers a duplicate of the coupon, or (iii) completes a qualifying action*. The Examiner does not explicitly assert otherwise. Accordingly, Applicants respectfully submit that the cited references do not suggest any of the following features:

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- *issuing a coupon having a variable benefit to a first recipient*
- *receiving an indication after a second recipient registers a duplicate of said coupon*
- *increasing a benefit of said coupon retained by said first recipient after said indication is received*

as recited in independent Claim 77;

- *issuing a coupon having a variable benefit to a first recipient;*
- *receiving an indication after a second recipient redeems a duplicate of said coupon; and*
- *increasing a benefit of said coupon retained by said first recipient after said indication is received.*

as recited in independent Claim 78; or

- *issuing a coupon having a variable benefit to a first recipient;*
- *receiving an indication after a second recipient completes a qualifying action; and*
- *increasing a benefit of said coupon retained by said first recipient after said indication is received*

as recited in independent Claim 79.

#### 4. Independent Claims 75 and 76

##### 4.1. The References Do Not Disclose All the Limitations of Independent Claims 75 and 76

As best understood by Applicants, the Examiner asserts the following to be true with respect to independent Claim 75 and 76:

(e) Christensen teaches all of the features of Claims 75 and 76 except  
• *generating a coupon having a variable benefit*

(f) Kanter suggests the above feature

Applicants respectfully traverse these assertions. Applicants have carefully reviewed the Christensen and Kanter references cited by the Examiner, without finding a teaching or suggestion of a *coupon having a variable benefit*, much less *generating a coupon having a variable benefit*.

Independent Claims 75 and 76 each recite *generating a coupon having a variable benefit*. As discussed above with respect to independent Claim 1, various embodiments of the present invention are directed to providing a coupon having a benefit that is variable or alterable according to established benefit variation condition(s). [Specification, page 7, lines 27 – 32.] As discussed above with respect to independent Claim 1, in contrast, and contrary to the Examiner's

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assertion, Kanter is devoid of any hint or suggestion of a coupon having a benefit that is variable.

In addition, Applicants respectfully traverse the Examiner's assertion that Christensen discloses the following features of independent Claim 75:

- receiving an indication that a first recipient has received a duplicate of said coupon from a second recipient after said second recipient has redeemed said coupon
- issuing a new coupon to said second recipient, the new coupon having a benefit corresponding to an incremental benefit said second recipient would have received had said coupon not been redeemed by said second recipient

The Examiner does not assert that Kanter discloses either of the above features.

Applicants have carefully reviewed both the Christensen and Kanter references cited by the Examiner, without finding a teaching or suggestion of either of the above features. Specifically, as neither Christensen nor Kanter teaches or suggests a coupon having a variable benefit, Christensen and Kanter cannot disclose a feature directed to receiving an indication that a first recipient has received a duplicate of a coupon having a variable benefit.

Further, there is no suggestion of an incremental benefit a second recipient would have received had said coupon not been redeemed by said second recipient, as recited in each of independent Claims 75 and 76; the Examiner does not assert otherwise. Accordingly, the cited references cannot teach or suggest issuing a coupon having a benefit corresponding to such an incremental benefit, as generally recited in independent Claim 75; or crediting to a financial account associated with a second recipient such an incremental benefit, as generally recited in independent Claim 76.

Applicants respectfully submit that the references do not disclose all of the limitations of independent Claims 75 and 76. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim 75 and 76.

If, on the other hand, Applicants' understanding as to what the Examiner is asserting with respect to independent Claims 75 and 76 is incorrect, Applicants request clarification of the list of items (e) - (f) above so that the present application may proceed to allowance or appeal.

#### 4.2. No Motivation to Combine the Cited References

As best understood by Applicants, the Examiner also asserts the following to be true with respect to independent Claims 75 and 76:

- (g) It would have been obvious to one of ordinary skill in the art to modify Christensen in light of Kanter to provide for a feature of generating a coupon having a variable benefit
- (h) The motivations for this modification in (g) above would be the same as (d) above

Applicants respectfully traverse the Examiner's asserted motivation to combine for the reasons stated above with respect to independent Claim 1. Specifically, Christensen and Kanter are not analogous art, and the asserted motivations of (d), beyond being a mere assertion by the Examiner that the claimed features would be advantageous, do not point out why it would have

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been obvious to one of ordinary skill in the art to provide for the specific feature of *generating a coupon having a variable benefit*, as recited in independent Claims 75 and 76.

Applicants respectfully submit that there is no suggestion in the prior art of record to combine the particular asserted teachings of the prior art to provide for all of the features of independent Claims 75 and 76. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of independent Claims 75 and 76.

If, on the other hand, Applicants' understanding of what the Examiner is asserting to be true is incorrect, Applicants request clarification of the list of items (e) - (h) above so that the present application may proceed to allowance or appeal.

#### 5. Independent Claims 109-111, 136-138, and 154-157

The Examiner rejects all of independent Claims 109-111, 136-138, and 154-157 "for substantially the same reasons" as independent Claim 75. Accordingly, for at least the reasons stated herein with respect to independent Claim 75, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to any of independent Claims 109-111, 136-138, and 154-157.

#### 6. All Dependent Claims (Claims 2-47, 49-57, 59-74, 80, 89, 97-106, 113-124, 126-128, 132-135, and 139-143)

As best understood by Applicants, the Examiner asserts the following to be true with respect to all of the dependent claims (Claims 2-47, 49-57, 59-74, 80, 89, 97-106, 113-124, 126-128, 132-135, and 139-143):

- (i) All of the features recited in Claims 2-47, 49-57, 59-74, 80, 89, 97-106, 113-124, 126-128, 132-135, and 139-143 were "well known and expected in the art...at the time of the invention" (Examiner's Official Notice)
- (j) It would have been obvious to one of ordinary skill in the art to modify Christensen in light of Kanter and in light of the Official Notice
- (k) The motivation for this modification in (j) is the same as in (d) above

##### 6.1. Official Notice

The Examiner's rejections of all of the dependent claims (Claims 2-47, 49-57, 59-74, 80, 89, 97-106, 113-124, 126-128, 132-135, and 139-143) are thus based in part on unsupported general assertions of what was "well known and expected" before the time of Applicants' invention. [Office Action, pages 5, 6, 7, 12, 14, 16, 18, 19, 21, 22.] Applicants respectfully traverse the Examiner's omnibus Official Notice of the recited features of all of the dependent claims (Claims 2-47, 49-57, 59-74, 80, 89, 97-106, 113-124, 126-128, 132-135, and 139-143).

Applicants note that the scope of the matter of which the Examiner takes Official Notice is limited to the substantial evidence in the record for such matter. The cited Kanter and Christensen references do not support the Examiner's broad assertions as to what was well known; the Examiner does not assert otherwise.

No references have been provided for any of the Examiner's assertions. Given that the only particular information in the record thus far regarding what is considered to be in the prior art is the Examiner's brief statement, Applicants cannot properly determine the bounds of the prior art. Accordingly, Applicants dispute that the subject matter asserted was "well known" at

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the time the invention was made, and request, for each of the dependent claims (Claims 2-47, 49-57, 59-74, 80, 89, 97-106, 113-124, 126-128, 132-135, and 139-143), a reference to clarify the subject matter in more detail. MPEP 2144.03.

Accordingly, the Examiner's sweeping assertions cannot be used as prior art to the present application – only the content of the references of record which are prior art to the present application may so used. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Further, Officially-Noted subject matter cannot be used as the basis for a rejection under 102 or 103. Official Notice may be used, if at all, only to clarify the meaning of a reference. See, e.g., In re Ahlert, 424 F.2d 1088 (C.C.P.A. 1969) ("Typically, it is found necessary to take notice of facts which may be used to supplement or clarify the teaching of a reference disclosure, perhaps to justify or explain a particular inference to be drawn from the reference teaching.") (emphasis added).

In other words, Official Notice of what existed in the prior art is not permitted. A reference must be provided to show the scope and content of the prior art. See, e.g., In re Ahlert, 424 F.2d 1088 (C.C.P.A. 1969) ("Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. ... Allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.") (emphasis added); In re Eynde, 480 F.2d 1364 (C.C.P.A. 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. Facts constituting the state of the art in a patent case are normally subject to the possibility of rational disagreement among reasonable men, and are not amenable to the taking of judicial or administrative notice.") (emphasis added); In re Pardo, 684 F.2d 912 (C.C.P.A. 1982) ("[T]his court will always construe [the rule permitting judicial notice] narrowly and will regard facts found in such manner with an eye toward narrowing the scope of any conclusions to be drawn therefrom. Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference.") (emphasis added)

#### 6.2. The References Do Not Disclose All the Limitations of Any of Claims 2-47, 49-57, 59-74, 80, 89, 97-106, 113-124, 126-128, 132-135, and 139-143

As discussed above, the Examiner's rejections of all of the dependent claims (Claims 2-47, 49-57, 59-74, 80, 89, 97-106, 113-124, 126-128, 132-135, and 139-143) are based in part on unsupported general assertions of what was "well known and expected" before the time of Applicants' invention. Applicants respectfully traverse the Examiner's omnibus Official Notice of the recited features of all of the dependent claims (Claims 2-47, 49-57, 59-74, 80, 89, 97-106, 113-124, 126-128, 132-135, and 139-143). The cited Kanter and Christensen references do not

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support the Examiner's broad assertions as to what was well known; the Examiner does not assert otherwise.

Applicants thus respectfully submit that the prior art of record does not disclose all of the limitations of any of dependent Claims 2-47, 49-57, 59-74, 80, 89, 97-106, 113-124, 126-128, 132-135, and 139-143. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of any of dependent Claims 2-47, 49-57, 59-74, 80, 89, 97-106, 113-124, 126-128, 132-135, and 139-143.

### **6.3. No Motivation to Combine the Cited References**

Even if all of the recited features of all of the dependent claims were well known, which Applicants dispute, there is no suggestion or motivation in the prior art of record to combine or modify the Christensen and Kanter references in light of the Officially-Noticed subject matter as suggested by the Examiner. As discussed above with respect to independent Claim 1, Christensen and Kanter are not analogous art, and the asserted motivations of (d), beyond being a mere assertion by the Examiner that the claimed features would be advantageous, do not point out why it would have been obvious to one of ordinary skill in the art to provide for any of the specific features of any of dependent Claims 2-47, 49-57, 59-74, 80, 89, 97-106, 113-124, 126-128, 132-135, and 139-143.

Applicants respectfully submit that the there is no suggestion in the prior art of record to combine the particular asserted teachings of the prior art to provide for all of the features of dependent Claims 2-47, 49-57, 59-74, 80, 89, 97-106, 113-124, 126-128, 132-135, and 139-143. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of dependent Claims 2-47, 49-57, 59-74, 80, 89, 97-106, 113-124, 126-128, 132-135, and 139-143.

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It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at [mdowns@walkerdigital.com](mailto:mdowns@walkerdigital.com).

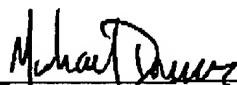
Petition for Extension of Time to Respond

Applicants hereby petition for a THREE-month extension of time with which to respond to the Office Action. Please charge \$465.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an additional extension of time is required, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,

March 5, 2003  
Date

  
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